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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,210	12/05/2001	Andrew M. Spencer	10014184-1	4151

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[REDACTED] EXAMINER

HESS, DANIEL A

ART UNIT	PAPER NUMBER
2876	

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/002,210	SPENCER, ANDREW M.
	<b>Examiner</b>	<b>Art Unit</b>
	Daniel A Hess	2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 February 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1 and 3-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1 and 3-9 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

### **DETAILED ACTION**

1. Acknowledgement is made of an amendment received by the Office on February 5, 2003, which has been placed in the file of record, and to which this action is a reply.

#### ***Remarks***

2. The applicant pointed out in the 2/5/2003 action that the controller 230 of Nelson (US 6,377,218) (see figure 2) is just for the RF module, and not for the entire component. Thus, the controller would not control the contact-based communication means. The examiner disagrees, noting that the bus 100 is (column 4, lines 35-40) a PCMCIA bus, which is a *contact* based interface. The controller 230 is in communication with both the bus 100 via an interface 240, which it communicates with directly. Since a controller (processor) operates in serial, it can only handle one stream of communication at a time. As a result, the controller 230 shown in figure 2, must choose to communicate on with one of 240 (wired communication to bus 100) or 220 (wireless communication with RF module 210).

As a result this action is made final.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 3-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson (US 6,377,218) in view of Gee et al. (US 5,619,396).

Re claims 1 and 5: Nelson shows a device, namely a PCMCIA card, having a wireless transmission means and a wireline connector (column 1, lines 5-12). Figure 2 shows the different modes of communicating: there is a contact means 240 and a contact-less means 210 (column 4, line 35-column 5, line 4). It is known in the art that contact-based communication is typically higher bandwidth (faster) than wireless (radio) type communication. As illustration, witness the bandwidth difference between television reception by air and television reception by cable. As shown in figure 2, both the contact-based means and the contactless means employ the same controller 230. Since a controller (processor) operates in serial, it can only handle one stream of communication at a time. As a result, the controller 230 shown in figure 2 must choose to communicate on with one of 240 (wired communication to bus 100) or 220 (wireless communication with RF module 210).

Nelson fails to show that the PCMCIA card has a memory mass storage. Nelson also fails to show that there is a memory card controller for selecting a data line from the one or the other of the two available interfaces to communicate with the memory mass storage.

Nelson fails to show that the PCMCIA card has a memory mass storage.

However, it is known that a PCMCIA card can be a memory card. The 'M' in PCMCIA stands for 'memory' and while the standard has grown to include other types of cards, cards having memory mass storage. Webopedia.com describes 'PCMCIA': "Short for *Personal Computer Memory Card International Association*, and pronounced as separate letters, PCMCIA is an organization consisting of some 500 companies that has developed a standard for small, credit card-sized devices, called *PC Cards*.

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Originally designed for adding memory to portable computers, the PCMCIA standard has been expanded several times and is now suitable for many types of devices."

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known memory mass storage as taught because this can add memory to portable computers, allowing a greater variety of more powerful applications to be run.

Re claims 3 and 4: As is shown in figure 2, the wired-mode and the wireless mode represent two distinct channels for communication, and could involve communication with two separate systems, one for each channel. Thus if a computer attempts to communicate with the card via contact means, the reply would be via the same channel. Why? Because the wireless means on the card may not even be in communication with the computer, but some other device, such as a LAN or the Internet (see figure 1, item 125) or with a peripheral device (see figure 1, item 135). Similarly, an attempt to communicate with the card wirelessly would result in an in-kind response.

Re claims 6-8: The card must have a way of receiving signals, and that way of receiving signals amounts to monitoring. As discussed re claims 3 and 4 above, the wired-mode and the wireless mode systems may operate different channels of communication. Thus it is implied that a wireless signal to the card draws a wireless response from the card. If the card is operating using the contact means and then (for example on a wireless LAN) a contactless communication comes in, it must respond in kind, thus switching to the wireless mode. Note the discussion re claim 2 above regarding the need to switch.

Re claim 9: The card may act as a connection means to a wireless network (column 4, lines 45-50). In order to be online on a wireless network, the card must first login or connect to

the network. This can happen automatically or manually through a user selection; however making the process automatic is not alone grounds for patentability.

In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined "old permanent- mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed." The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.).

Nelson fails to show that the monitoring and switching occurs at start-up.

The examiner takes Official Notice that desktop computers he has used automatically connect to the local network on startup, prior to the invention by the applicant.

In view of this old and well-known technology, it would therefore have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known automatic connection to the network at startup into the teachings of Nelson because this permits instant access to network functionality without the need to wait for a connection to take place.

#### *Response to Arguments*

5. Applicant's arguments filed 2/5/2003 have been fully considered but they are not persuasive. The applicant claims that the controller 230 is not involved with a contact-based interface. However, a comparison of figures 1 and 2 of Nelson can be made to refute this. Figure 1 shows that a wireline bus 100 connects the peripheral component 108 to a host device

120. In figure 2, we see elements 100 and 120, making clear that the controller 230 is indeed in communication with them.

6. Nelson shows (abstract, lines 6-9; column 2, lines 21-24) show that a wireless interface is connected to certain circuitry and a wireline interface is connected to that same circuitry. This 'logical circuitry' is not discussed in depth, but it certainly can include an overall microprocessor and memory as illustrated in figure 2 of Gee.

7. The examiner stresses that in teaching a PCMCIA card Nelson shows *a* [singular] device, namely a PCMCIA card, with two interfaces, one wired and one wireless. The interfaces are just two separate channels into a single device. Therefore switching between these two channels would be expected.

### *Conclusion*

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

9. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A Hess whose telephone number is (703) 305-3841. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

12. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



DH

March 18, 2003

Daniel A Hess  
Examiner  
Art Unit 2876



KARL D. FRECH  
PRIMARY EXAMINER